

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application, including the detailed response to arguments found on pages 2-10 of the outstanding Office Action, which is discussed in connection with Applicants' traversal of the outstanding rejections of record.

Claims 1-3, 5, 6, 8-11, 13-15, 17-20, 22-29 and 31-39 are pending. Claims 1, 11 15, 19, 22, 23, 26, 29 and 32 are independent.

Rejection of claims 1-3, 5, 6, 8, 9, 36 and 38 under 35 U. S. C. §103(a)

Claims 1-3, 5, 6, 8, 9, 36 and 38 stand rejected under 35 U.S.C. §103(a) as unpatentable over Tracton in view of Cerna and further in view of Margulis U.S. Patent 6,263,503 (hereinafter, "Margulis"). This rejection is respectfully traversed.

Initially, Applicants note that this rejection is moot with respect to claims 4 and 6, which have been canceled.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. These showings must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See, In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Tracton discloses a cellular-phone and an original source that can be encoded with spatial scalability, where a low-resolution (for low-bandwidth clients) data stream is encoded along with a higher-resolution version. When a low-resolution client contacts the server, the server can quickly de-multiplex the source and present only the low-resolution data. Other adjustments to the source data include reducing display size, color depth, level of detail, etc. Note, however, that the server can be configured to fall-back to providing pre-scaled resources (e.g., FIG. 5) if the server is temporarily overloaded" (See cols. 7-8, lines 62-65).

Furthermore, Tracton discloses a server that can appropriately scale 174 the original source content according to client capabilities, network speed, and other abilities/restrictions indicated in the profile. The scaled content is then sent 176 to the client (See col. 5, lines 58-62).

However, Tracton does not teach (1) a converting unit in a television receiver for converting video and audio signals provided from moving picture information from a TV broadcast station into a format compatible with a signal and transmission standard of a mobile radio communication system, or (2) a converting unit that comprises a coding unit which codes the video and audio signals to be compatible with a digital television broadcasting system and formats the coded video and audio signals to be compatible with the mobile radio communication system, as in the claimed invention.

Instead, Tracton deals with scaling network content according to data-recipient characteristics such as processing ability and client-to-server network throughput. A server disclosed by Tracton has pre-prepared several versions of an original source material, and embedded selection logic into the web page, where this logic directs the client's browser to an appropriate source based on testing the client capabilities (see col. 6, lines 3-7, for example).

Tracton neither discloses nor suggests a converting unit in a TV receiver and is completely non-analogous art to the claimed invention.

The outstanding Office Action incorrectly states, on page 4, that Tracton "clearly discloses that the original source content 250 may be a MPEG encoded news broadcast or 'television broadcast' that is sent to a server or 'television [signal] receiver'. . .," citing col. 4, lines 33-49; col. 5, lines 58-62; and col. 7, line 26 to col. 8, line 5.

In actuality, Tracton never explicitly mentions the word "television" or "television receiver" anywhere, let alone in the afore-referenced portions of the reference.

Instead, Tracton's exemplary embodiments are limited to a typical internet context (col. 8, lines 13-22, for example) and the main disclosed embodiment, which is disclosed starting at col. 9, line 6, is a computer 402 having a processor 406, a hard drive 410, optical/laser storage devices 414, a video system 416, e.g., a 2D and/or 3D graphics rendering device, and an output device such as, for example, a monitor, LCD display and a recording device.

In this regard, Applicants respectfully submit that for something like a television receiver to be disclosed in a reference used in a rejection under 35 U.S.C. §102 and/or §103, it must be disclosed explicitly or inherently. Clearly, a television receiver is not explicitly disclosed. Nor is it inherently disclosed by Tracton because to be inherently disclosed, it must necessarily be disclosed, i.e., not just possibly disclosed or not just probably disclosed. “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Nor do Cerna or Margulis teach or suggest the recited “converting unit in a television receiver for converting video and audio signals provided from moving picture information from a TV broadcast station into a format compatible with a signal and transmission standard of a mobile radio communication system, wherein the converting unit comprises a coding unit which codes the video and audio signals to be compatible with a digital television broadcasting system and formats the coded video and audio signals to be compatible with the mobile radio communication system,” as in the claimed invention.

The outstanding Office Action responds to this previously presented argument “because of the response above given for Tracton.” However, as noted above, the Office Action mischaracterizes what Tracton discloses. Tracton simply does not disclose a television receiver, either expressly or implicitly. Tracton

discloses a user-operated computer operating over the internet. Tracton discloses that the computer can have a video rendering card but does not disclose that the computer has a TV tuner that can receive a broadcast television signal, either explicitly or inherently. In this regard, Applicants respectfully note that the claims positively recite a converting unit in a television receiver for converting video and audio signals provided from moving picture information from a TV broadcast station. Tracton is totally devoid of such a positively recited feature, as are the two secondary references, i.e., Cerna and Margulis.

Therefore, the present invention as claimed in amended independent claim 1 could not have been realized from Tracton taken in combination with Cerna and Margulis, because combining the references as cited by the Examiner would not provide at least the recited coding unit which codes the video and audio signals to be compatible with a digital television broadcasting system and formats the coded video and audio signals to be compatible with the mobile radio communication system as in the claimed invention, and thus the combined teachings of these references are not capable of resulting in, or rendering obvious, the claimed invention.

Furthermore, the Office Action fails to make out a *prima facie* case of proper motivation to combine these three references as suggested. As noted above Tracton is only directed to client-to-server network communications with the disclosed examples directed to office networks and the Internet.

Cerna is only directed to multi-channel telephonic communications systems which makes optimum use of trunk line resources while having an architecture

that allows for expansion and without undue multiplicity (see col. 2, lines 64-68, for example). Cerna uses a packet switching architecture rather than a routing architecture (col. 3, lines 1-18), switching packets from a source node to a desired destination node (col. 3, lines 45-48, for example). Cerna has no disclosed connection to the client-server disclosure of Tracton.

Margulis is directed to a wireless television system “preferably configured for economical and efficient use in a home environment” (col. 4, lines 13-15, for example). It is non-analogous art to both Tracton and Cerna, neither of which is directed to a wireless TV system.

The alleged commonality of Cerna and Tracton is that they teach methods of transporting scaled data over digital networks. Applicants’ response to this is that there are possibly hundreds or thousands of patents that share this feature, but that shared characteristic is nothing more than a broad conclusory statement about the teaching of multiple references, which standing alone, are not “evidence” of proper motivation to modify one reference in view of the other reference. Such generic shared characteristics are not the clear and particular type of evidence needed to motivate one of ordinary skill in the art to modify Tracton in view of Cerna. Compare In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999), cited above.

In this regard, the outstanding Office Action, in the “response to arguments” section focus on similarities between Tracton and Cerna. In particular, the Office Action states that Tracton teaches varying the rate and transmission bandwidth of video in a cellular telephone system, varying an encoding rate of video signals and

a transmission bandwidth of the video signals according to client capabilities, network speed and other characteristics using a cellular transmission system, and that Cerna uses flow control in a telecommunications system to dynamically adjust the bandwidth being used by adjusting the quality of the voice data to prevent insufficient bandwidth and lost data, and handles fax and computer data.

Applicants' response to this is that these similarities are shared by a number of digital data transmission systems but these similarities do not provide objective factual evidence of proper motivation to modify Tracton's internet based client-server system, which primarily is a signal routing system, in view of Cerna's multi-channel telephone switching system (described in col. 3, lines 10-18 as having a switching architecture, not a routing architecture) in some unspecified way to maximize the number of connections the network can support to minimize cost (see page 13 of the outstanding Office Action, which does not specify what specific elements of Tracton are to be modified by what specific elements of Cerna to achieve this broad goal in a manner that will somehow minimize cost, the cost of what not being specified, either).

Moving along, the Office Action states that neither Tracton nor Cerna disclose what Margulis discloses regarding a wireless television and provides absolutely no objective factual evidence of why one of ordinary skill in the art would turn to Margulis' wireless TV system to be motivated to modify the improper reference combination of Tracton and Cerna, neither of which has any disclosure about wireless TV systems. The alleged reason to combine these references is "in



order to allow a user to access a wide variety of programming when a regular television is not accessible.”

However, neither Tracton nor Cerna discloses any interest in accessing a wide variety of TV programming when a regular TV is not accessible. As noted above, Tracton does not disclose a TV tuner in its disclosed computer, or a TV receiver in general, nor does Cerna. In fact, Cerna is directed to a telephone packet switching system and shows no interest whatsoever in receiving broadcast TV. In other words, this motivation is pure speculation unrelated to the references that are sought to be modified.

Accordingly, the Office Action fails to make out a *prima facie* case of proper motivation to modify Tracton in view of Cerna and/or to modify Tracton and Cerna in view of Margulis.

This failure, coupled with the failure of any of the references to disclose the aforementioned positively recited features, leads to the conclusion that the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention. Thus, the rejection is improper and the claims are allowable.

#### Rejection of Claim 10

Claim 10 stands rejected under 35 U.S.C. §103(a) as unpatentable over Tracton in view of Cerna and further in view of Margulis and further in view of U.S. patent 6,246,430 to Peters et al. (“Peters”). This rejection is respectfully traversed.

The aforementioned Tracton-Cerna-Margulis reference combination is improper for reasons discussed above and does not render obvious claim 1, from which claim 10 depends. Moreover Peters is not applied to remedy the deficiencies in the aforementioned reference combination.

For at least these reasons alone, this rejection is improper.

Peters is non-analogous art to whatever the Tracton-Cerna-Margulis reference combination is supposed to be. The Office Action never says what this reference combination results in, i.e., whether it is, for example, a wireless TV system or an internet client-server system, or a videophone system.

Whatever the Tracton-Cerna-Margulis reference combination is, the Office Action has not made out a *prima facie* case to modify this improper reference combination in view of Peters because the Office Action has not clearly established what type of system results from this reference combination.

Moreover, even if it were obvious to somehow modify the aforementioned improper Tracton-Cerna-Margulis reference combination in view of Peters, the resulting reference combination would not render obvious the claimed invention because all of the features of claim 1 are recited in claim 10.

#### Rejection of Claims 11-14 and 37

Claims 11-14 and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tracton in view of Cerna and further in view of Margulis and still further in view of Legall et al. U.S. Patent No. 6,005,565 (hereinafter, "Legall"). This rejection is respectfully traversed.

Applicants note that this rejection is moot with respect to claim 12, which has been canceled.

In the first place, Applicants respectfully submit that the Tracton-Cerna-Margulis reference combination is improper for the reasons stated above.

In addition, Tracton discloses a network application 112 connected to Internet 104 (See Figure 4, 112). Tracton also discloses a computing device 402 having system bus 404 for coupling together various components within the computing device. The system bus 404 disclosed by Tracton may be any of several types of bus structures including a memory bus or memory controller, a peripheral bus, and a local bus using any of a variety of conventional bus architectures such as PCI, AGP, VESA, Microchannel, ISA and EISA, to name a few (See col. 9, lines 6-20).

However, Tracton does not teach or suggest the recited “TV broadcast digital video and audio signal reception unit and decoder which decodes TV broadcast digital video and audio signals received from the TV broadcast digital video and audio signal reception unit,” as in the claimed invention.

Moreover, neither Cerna, Margulis nor Legall teach or suggest a “TV broadcast digital video and audio signal reception unit and decoder which decodes TV broadcast digital video and audio signals received from the TV broadcast digital video and audio signal reception unit,” as recited in the claimed invention.

The outstanding Office Action responds to this previously presented argument by stating that it is inherent that a device or system that receives TV broadcast digital video and audio signals includes a decoder. While this may be

true, none of the applied references discloses a broadcast TV receiver. The Office Action has not demonstrated where such a positively recited feature is disclosed in any of these applied references.

The present invention as claimed in amended independent claim 11 could not have been realized from Tracton taken in combination with Cerna, Margulis and Legall, because combining the references as cited by the Examiner would not provide the recited TV broadcast digital video and audio signal reception unit and decoder which decodes TV broadcast digital video and audio signals received from the TV broadcast digital video and audio signal reception unit as in the claimed invention, and thus the combined teachings of these references are not capable of performing the claimed invention's functions.

Furthermore, Legall contains no disclosure of transmitting television programs and is non-analogous to all three of the references it is used to modify in this rejection.

The alleged motivation to incorporate the EPG searching of Legall into the aforementioned improper reference combination is because "Legall is evidence that ordinary workers would appreciate the ability to search an EPG." Applicants respectfully disagree. Just because someone would want to search an EPG does not mean that they would modify the aforementioned improper reference combination to search an EPG the way Legall does, especially in view of the fact that Legall does not even mention the word "television" in its application and does not deal with wireless broadcast television, like Margulis does.

Accordingly, the office Action fails to make out a *prima facie* case of proper motivation to modify the aforementioned Tracton-Cerna-Margulis improper reference combination in view of Legall.

Moreover, as noted above, even if it were proper to combine these references, they would not result in a reference combination that would render obvious the claimed invention because they do not teach all of the features recited in these claims.

Rejection of Claims 15-25 and 29-30

Claims 15-25 and 29-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Margulis in view of Cerna. This rejection is respectfully traversed.

Initially, Applicants note that this rejection is moot with respect to claims 16, 21 and 30, which have been cancelled.

Margulis discloses program guide information and/or video channel guide information, which may be provided as a program source 112, or may be incorporated into another program source 112. Such program guide information disclosed by Margulis may be provided in any suitable manner, including from a television broadcast vertical-blanking interval (VBI) signal, from MPEG system data, or from the Internet through a wide-area network (WAN) connection (see col. 4, lines 44-55).

However, Margulis and Cerna do not teach or suggest the recited (1) EPG (Electronic Program Guide) data converting unit for converting the EPG data for selecting a digital broadcast channel, in general, or (2) into a format agreeable to

the mobile radio communication system, and (3) additional information converting unit for converting additional information of the digital broadcast signals, in general, or (4) into a format agreeable to the mobile radio communication system, as in the claimed invention.

Furthermore, Margulis does not teach or suggest the recited detailed features of the data processing and converting unit as stated in claim 19.

Also, Margulis and Cerna do not teach or suggest the recited features of converting a TV broadcast signal including digital video and audio signals wherein EPG (Electronic Program Guide) data is formatted and multiplexed together with and transmitted with the video and audio signals and additional information in a TV receiver into a format compatible with a signal and transmission standard of a mobile radio communication system, and transmitting the converted digital video and audio signals to a mobile communication subscriber terminal through a certain transmission channel of the mobile radio communication system, as stated in claim 23.

Furthermore, Margulis and Cerna do not teach or suggest at least the recited encoding-converting unit for converting the abstracted EPG signal and the additional information into a signal compatible with the mobile radio communication system, as stated in claim 29.

In response to these arguments, the outstanding Office Action states, among other things, that it is inherent that at least one transmission channel be allotted for transmission of data, presumably with reference to claim 22, that recites a combination of features including a transmitting unit for transmitting the

converted data to a certain channel of the mobile radio communication system. Applicants respectfully request that objective factual evidence be provided to show the existence of such an allegedly inherent feature. See, in this regard, In re Lee, cited above. Moreover, as noted above, what is alleged to be inherent must be shown to necessarily occur, and no such showing has been made by the Office.

Therefore, the present invention as claimed in amended independent claims 15, 19, 23 and 29 could not have been realized from Margulis taken in combination with Cerna because combining the references as cited by the Examiner would not provide at least the recited EPG (Electronic Program Guide) data converting unit for converting the EPG data for selecting a digital broadcast channel into a format agreeable to the mobile radio communication system and additional information converting unit for converting additional information of the digital broadcast signals into a format agreeable to the mobile radio communication system as in the claimed invention, and thus the combined teachings of these references are not capable of performing the claimed invention's functions.

Moreover, for reasons discussed above, the Office Action does not make out a *prima facie* case of proper motivation to modify Tracton in view of Cerna.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention recited in these claims.

Rejection of Claim 26

Claim 26 is rejected under 35 U.S.C. §103(a) as being unpatentable over Margulis in view of Cerna and further in view of Legall. This rejection is respectfully traversed.

Margulis discloses a method for effectively implementing a wireless television system which comprises a wireless base station and a transmitter which responsively transmits a processed stream as a broadcast output stream to various portable wireless display devices for flexible viewing at variable remote locations.

Cerna discloses a power search tool including query tools for specifying and selecting the filter elements used to perform the search. The user can select the information sources to be searched, such as the World Wide Web and electronic program guide (EPG) information (See col. 2, lines 60-66).

However, Margulis, Cerna and Legall do not teach or suggest at least the recited features of converting video and audio data of the selected channel into a format compatible with a standard of the mobile radio communication system, and transmitting the converted data through a certain transmission channel of the mobile radio communication system, as stated in claim 26.

The present invention as claimed in amended independent claim 26 could not have been realized from Margulis taken in combination with Cerna and Legall, because combining the references as cited by the Examiner would not provide at least the recited features of converting video and audio data of the selected channel into a format compatible with a standard of the mobile radio



communication system, and transmitting the converted data through a certain transmission channel of the mobile radio communication system as in the claimed invention, and thus the combined teachings of these references are not capable of performing the claimed invention's functions.

Furthermore, the Office Action has not made out a *prima facie* case of proper motivation to modify Margulis in view of Cerna or of modifying the Margulis-Cerna reference combination in view of Legall.

Margulis is directed to a wireless television system "preferably configured for economical and efficient use in a home environment" (col. 4, lines 13-15, for example). It is non-analogous art to Cerna, which is not directed to a wireless TV system.

Cerna is only directed to multi-channel telephonic communication systems which makes optimum use of trunk line resources while having an architecture that allows for expansion and without undue multiplicity (see col. 2, lines 64-68, for example). Cerna uses a packet switching architecture rather than a routing architecture (col. 3, lines 1-18), switching packets from a source node to a desired destination node (col. 3, lines 45-48, for example). Cerna has no disclosed connection to the wireless television system of Margulis.

Legall contains no disclosure of transmitting television programs and is non-analogous to both of the references it is used to modify in this rejection.

The Office Action offers no reason to modify Margulis in view of Cerna and the alleged reason to modify the improper Margulis-Cerna reference combination

is because one of ordinary skill in the art would appreciate the ability to search an EPG.

Applicants respectfully disagree. Just because someone would want to search an EPG does not mean that they would modify the aforementioned improper reference combination to search an EPG the way Legall does, especially in view of the fact that Legall does not even mention the word "television" in its application and does not deal with wireless broadcast television, like Margulis does.

Accordingly, the office Action fails to make out a *prima facie* case of proper motivation to modify the aforementioned Margulis-Cerna improper reference combination in view of Legall.

Thus, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention recited in this claim.

In response to these arguments, the outstanding Office Action states, among other things, that it is inherent that at least one transmission channel be allotted for transmission of data, presumably with reference to claim 22, that recites a combination of features including a transmitting unit for transmitting the converted data to a certain channel of the mobile radio communication system. Applicants respectfully request that objective factual evidence be provided to show the existence of such an allegedly inherent feature. See, in this regard, In re Lee, cited above. Moreover, as noted above, what is alleged to be inherent must be shown to necessarily occur, and no such showing has been made by the Office.

Rejection of Claims 27 and 28

Claims 27 and 28 stand rejected under 35 U.S.C. §103(a) as unpatentable over Margulis in view of Cerna and Legall and further in view of Peters et al., U.S. Patent 6,246,430 (hereinafter, "Peters"). This rejection is respectfully traversed.

These claims depend from claim 26, which is patentable over the Margulis-Cerna-Legall reference combination for the reasons stated above. For at least these reasons, claims 27 and 28 are patentable over Margulis and Cerna.

Moreover, Peters is not applied to remedy the deficiencies of Margulis, Cerna and Legall. Accordingly, claims 27 and 28 are not obvious in view of Margulis, Cerna, Legall and Peters.

Reconsideration and withdrawal of this rejection are respectfully requested.

Rejection of Claims 31-35 and 39

Claims 31-35 and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Margulis in view of Cerna and further in view of Tracton.

Margulis discloses an RF subsystem (See Figure 7, 724) and a remote controls 312 which may be used by a viewer to control various components and operating parameters of wireless television system 110 (See Figure 3, 312).

However, Margulis, Cerna and Tracton do not teach or suggest at least the recited selecting unit for selecting a TV broadcast signal reception mode and a mobile communication telephone call mode, as stated in claim 32.

In response to this previously presented argument, the outstanding Office Action asserts that it is inherent in Tracton to have a selection means for selecting a broadcast signal mode or a mobile communications telephone call mode. Applicants respectfully disagree and respectfully request objective factual evidence that such a feature necessarily exists in Tracton.

Furthermore, what is recited is not just a selection means for selecting a broadcast signal mode or a mobile communications telephone call mode. The claimed invention recites a combination of features including a selecting unit for selecting a TV broadcast signal reception mode and a mobile communication telephone call mode. This feature is not disclosed in any of the applied references. Moreover, the Office Action has not demonstrated by objective factual evidence that one of ordinary skill in the art would be properly motivated to modify Margulis and Cerna as suggested in view of Tracton because of the significant differences between these references.

Therefore, the present invention as claimed in amended independent claim 32 could not have been realized from Margulis taken in combination with Cerna and Tracton because combining the references as cited by the Examiner would not provide at least the recited selecting unit for selecting a TV broadcast signal reception mode and a mobile communication telephone call mode as in the claimed invention, and thus the combined teachings of these references are not capable of performing the claimed invention's functions.

The aforementioned Margulis-Cerna reference combination is improper for reasons discussed above. Moreover Applicants respectfully submit that it would

not be obvious to modify the improper Margulis-Cerna reference combination to use an MPEG 4 format because it would not be proper to achieve the improper Margulis-Cerna reference combination, for reasons discussed above.

Moreover, as pointed out above, Tracton is non-analogous to Margulis and Cerna, so the Office Action has not made out a *prima facie* case of proper motivation to modify the improper Margulis-Cerna reference combination in view of the non-analogous Tracton's internet client server device.

Accordingly, the Office Action has failed to make out a *prima facie* case of obviousness of the claimed invention recited in these claims.

#### Conclusion

Accordingly, for at least the foregoing reasons, the invention as recited in amended independent claims 1, 11, 15, 19, 23, 26, 29 and 32 and all the dependent claims (due to their dependency) is patentable over the applied prior art of record, including Tracton, Cerna, Margulis, Legall and Peters, and thus the Examiner's final rejections under 35 U.S.C. § 103(a) should be withdrawn. Applicants have responded to the rejections of record and to the Examiner's "Response to Arguments" portion of the Office Action, found on pages 2-10 of the outstanding Office Action.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster (Reg. No. 46,472) at the telephone number of the undersigned below, to

conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Esther H. Chong  
Esther H. Chong, #40,953

EHC/RJW:gf  
0630-1127P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000